

PATENT  
674519-2001.4REMARKS

The Office Action rejected claims 12-16 and 19 were rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,653,298. Applicants maintain that the rejection should be withdrawn, and submit the following arguments that the rejection is improper.

The claims of U.S. Patent No. 6,653,298 relates to methods for oral contraception, wherein the dosage administered to the patient is no greater than 200 mg/day per 70 kg subject. In contrast, the presently pending claims relate to pharmaceutical compositions.

It is respectfully submitted that in the immediate parent of the present application, USSN 09/794,853, which was also subject to examination by Examiner Radio, an Office Action dated August 30, 2001 required restriction from among methods of inhibiting steroid sulfatase, and pharmaceutical compositions (copy attached). By subsequently rendering the restriction requirement final, these groups of claims were determined by Examiner Radio to be patentably distinct from each other.

As the present application was filed as a divisional of USSN 09/794,853 as a result of the restriction requirement, the present application is not subject to a rejection based on the method claims of the parent application that were considered patentably distinct by the Examiner. See 35 U.S.C. §121. It is respectfully asserted that, similarly, the present application should not be subject to rejections based on the method claims of a related patent.

Accordingly, Applicants respectfully submit that as the Examiner has previously determined in the parent application that methods and pharmaceutical compositions relating to the instant invention are patentably distinct, it is therefore improper to base a double patenting rejection on a patent claiming methods that are patentably distinct from the pharmaceutical compositions of the present invention.

Accordingly, it is respectfully submitted that the method claims of U.S. Patent No. 6,653,298 are patentably distinct from the present claims to pharmaceutical compositions. Consequently, the rejection should be withdrawn. Therefore, in view of the remarks herein, reconsideration and withdrawal of the double patenting rejection is respectfully requested.

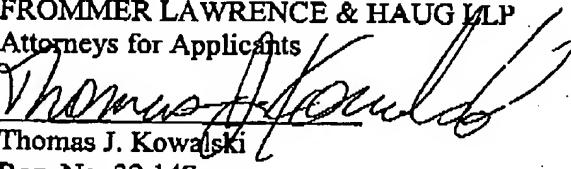
PATENT  
674519-2001.4CONCLUSION

In view of the remarks and attachments herewith, the application is in condition for allowance. Favorable reconsideration of the application, and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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